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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,150	11/02/2001	Shell Sterling Simpson	10008212-1	7884

7590

08/25/2005

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/003,150

**Applicant(s)**

SIMPSON ET AL.

**Examiner**

Mark Fadok

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 14-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Election***

The examiner is in receipt of applicant's response to office action mailed 1/26/2005, which was received 6/3/2005. Acknowledgment is made to the election of Group IA with traverse, leaving claims 1-7 and 11-13 as pending in the instant application.

1) Applicant argues that the applicant will need to file additional application to provide coverage for system and device claim. The examiner informs applicant that once allowable subject matter is found in the method claims, the applicant will be permitted through rejoiner to add additional coverage for the system and device provided that the new claims are formulated as parallel claims containing the same features as the method claim and would be obvious one independent claim over the other.

2) Applicant admits that each of Groups 2 and 3 are independent and distinct.

3) Applicant argues that there would not be a burden to the examiner since the examiner only need to search in one sub class. The examiner points out to the applicant that the examiner may not limit the office's search to only one class and is further required to search foreign and Non-Patent Literature. Therefore since the restriction is provided a-priori, the actual burden to the examiner is indeterminable.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-7 and 11,13 are rejected under 35 U.S.C. 102(e) as being anticipated by Garfinkle (US 6,924,878).**

**In regards to claim 1**, Garfinkle discloses a method for facilitating pay printing (abstract), comprising the steps of:

accessing imaging data from at least one store via a network (FIG 7);

receiving print option selections (FIG 6 and 7); and

determining printing costs (FIG 7A).

**In regards to claim 2**, Garfinkle teaches wherein the at least one store comprises a graphic store and a composition store (FIG 1).

**In regards to claim 3**, Garfinkle teaches wherein the at least one store is associated with an imaging source (FIG 1, item 16).

**In regards to claim 4**, Garfinkle teaches wherein the imaging source comprises a network-based imaging service (FIG 1).

**In regards to claim 5**, Garfinkle teaches wherein the step of accessing imaging data comprises retrieving imaging data from the at least one store (FIG 1).

**In regards to claim 6**, Garfinkle teaches wherein the step of retrieving imaging data comprises retrieving a scaled-down version of a document (col 6, lines 1-20).

**In regards to claim 7**, Garfinkle teaches wherein the scaled down version comprises one or more thumbnails that represent document pages (see response to claim 6).

**In regards to claim 11**, Garfinkle teaches wherein the step of receiving print option selections comprises receiving user selections with a web site of a network-based pay-for-print service (FIG 5D).

**In regards to claim 13**, Garfinkle teaches wherein the determination of the printing costs is dependent upon attributes of the imaging data and the option selections (FIG 5D).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of Official Notice.**

In regards to claim 12, teaches a pay-for-print service that is supported by servers, but does not specifically mention that the service is supported by a printing device having an embedded server. It was old and well known in the art at the time of the invention to provide printing devices with embedded servers. It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide printing devices with embedded servers, because theses devices would be acting as a vending machine for distributing the product and could therefore do some of the processing locally rather than having to be in communication with a remote server thus removing potential bandwidth issues.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(571) 272-**

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**6755.** The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(571) 272-7159**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is **(571) 272-3600**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(571) 273-8300** [Official communications; including

After Final communications labeled

"Box AF"]

**(571) 273-6755** [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]



Mark Fadok

Primary Examiner